



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE United States Patent and Trademark Office Address: COMMISSIONER FOR PATENTS P.O. Box 1450 Alexandria, Virginia 22313-1450 www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/769,239	01/31/2004	Wei Zhang	K35R1865	8179
35219 75	90 10/16/2006		EXAMINER	
WESTERN DI	IGITAL TECHNOLOG	RENNER, CRAIG A		
20511 LAKE F	-		ART UNIT	PAPER NUMBER
E-118G			2627	
LAKE FOREST, CA 92630			DATE MAILED: 10/16/2006	

Please find below and/or attached an Office communication concerning this application or proceeding.

		·			
		Application No.	Applicant(s)		
		10/769,239	ZHANG ET AL.		
.	Office Action Summary	Examiner	Art Unit		
		Craig A. Renner	2627		
Period fo	The MAILING DATE of this communication app or Reply	pears on the cover sheet with the c	orrespondence address		
A SH WHIC - Exte after - If NC - Failu Any	ORTENED STATUTORY PERIOD FOR REPLY CHEVER IS LONGER, FROM THE MAILING DANSIONS of time may be available under the provisions of 37 CFR 1.13 SIX (6) MONTHS from the mailing date of this communication. O period for reply is specified above, the maximum statutory period we tree to reply within the set or extended period for reply will, by statute, reply received by the Office later than three months after the mailing ed patent term adjustment. See 37 CFR 1.704(b).	ATE OF THIS COMMUNICATION 36(a). In no event, however, may a reply be tin will apply and will expire SIX (6) MONTHS from , cause the application to become ABANDONE	N. nely filed the mailing date of this communication. D (35 U.S.C. § 133).		
Status					
1)⊠	Responsive to communication(s) filed on <u>02 Au</u>	<u>ugust 2006</u> .			
2a) <u></u> ☐	This action is FINAL . 2b)⊠ This action is non-final.				
3)[Since this application is in condition for allowance except for formal matters, prosecution as to the merits is				
	closed in accordance with the practice under E	Ex parte Quayle, 1935 C.D. 11, 45	53 O.G. 213.		
Disposit	ion of Claims				
5) 6) 7)	Claim(s) <u>1-55</u> is/are pending in the application. 4a) Of the above claim(s) <u>41-54</u> is/are withdraw Claim(s) is/are allowed. Claim(s) is/are rejected. Claim(s) is/are objected to. Claim(s) <u>1-40 and 55</u> are subject to restriction	vn from consideration.			
Applicat	ion Papers				
10)	The specification is objected to by the Examine The drawing(s) filed on is/are: a) access Applicant may not request that any objection to the Replacement drawing sheet(s) including the correct The oath or declaration is objected to by the Examine	epted or b) objected to by the I drawing(s) be held in abeyance. Sec ion is required if the drawing(s) is ob	e 37 CFR 1.85(a). jected to. See 37 CFR 1.121(d).		
Priority (under 35 U.S.C. § 119				
а)	Acknowledgment is made of a claim for foreign All b) Some * c) None of: 1. Certified copies of the priority documents 2. Certified copies of the priority documents 3. Copies of the certified copies of the prior application from the International Bureau See the attached detailed Office action for a list	s have been received. s have been received in Applicati rity documents have been receive u (PCT Rule 17.2(a)).	on No ed in this National Stage		
Attachmen	ut(s) te of References Cited (PTO-892)	4) ☐ Interview Summary	(PTO-413)		
2) Notice (3) Infon	the of References Cited (P10-892) the of Draftsperson's Patent Drawing Review (PT0-948) mation Disclosure Statement(s) (PT0/SB/08) er No(s)/Mail Date	4) Interview Summary Paper No(s)/Mail Da 5) Notice of Informal P 6) Other:	ate		

Application/Control Number: 10/769,239

Art Unit: 2627

1. Applicant's election without traverse of group "I, including Claims 1-40 and 55" in the reply filed on 02 August 2006 is acknowledged. Accordingly, claims 41-54 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to one or more non-elected inventions/species, there being no allowable generic or linking claim.

Page 2

- 2. Upon further consideration, restriction to one of the following inventions is required under 35 U.S.C. 121:
 - Claims 1-40, drawn to a "magnetoresistive read head" with "at least one dusting layer", classified in class 360, subclass 324.
 - II. Claim 55, drawn to a "magnetoresistive read head" with a particular "grain size" configuration, classified in class 360, subclass 324.12.
- 3. The inventions are distinct, each from the other because of the following reasons:

Inventions of groups I and II are related as combination and subcombination, respectively. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the combination does not require for "the average bias layer grain size being larger than the average underlayer grain size", for instance. The subcombination has separate utility,

Application/Control Number: 10/769,239 Page 3

Art Unit: 2627

such as, usable with a magnetoresistive read head not having "at least one dusting layer", for instance.

The examiner has required restriction between combination and subcombination inventions. Where applicant elects a subcombination, and claims thereto are subsequently found allowable, any claim(s) depending from or otherwise requiring all the limitations of the allowable subcombination will be examined for patentability in accordance with 37 CFR 1.104. See MPEP § 821.04(a). Applicant is advised that if any claim presented in a continuation or divisional application is anticipated by, or includes all the limitations of, a claim that is allowable in the present application, such claim may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application.

- 4. Because these inventions are independent or distinct for the reasons given above and there would be a serious burden on the examiner if restriction is not required because the inventions have acquired a separate status in the art in view of their different classification, restriction for examination purposes as indicated is proper.
- 5. This application also contains claims directed to the following patentably distinct species:

Species I - FIGS. 1A and 2A-2F.

Species II - FIGS. 1B and 7A-7D.

Species III - FIG. 1C.

Species IV - FIG. 3A.

Species V - FIG. 3B.

Species VI - FIGS. 4A and 5A.

Application/Control Number: 10/769,239 Page 4

Art Unit: 2627

Species VII - FIGS. 4B, 5B and 6. Species VIII - FIGS. 8 and 9.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, at least claim 1 appears to be generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which depend from or otherwise require all the limitations of an allowable generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species.

MPEP § 809.02(a).

- 6. A telephone call was made to Jonathan E. Prejean, Esq. on 14 October 2006 to request an oral election to the above restriction requirement, but did not result in an election being made.
- 7. Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species or invention to be examined even though the

Art Unit: 2627

requirement be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention or species may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

Should applicant traverse on the ground that the inventions or species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions or species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C.103(a) of the other invention.

- 8. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).
- 9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Craig A. Renner whose telephone number is (571) 272-

Art Unit: 2627

7580. The examiner can normally be reached on Monday-Tuesday & Thursday-Friday 9:00 AM - 7:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hoa T. Nguyen can be reached on (571) 272-7579. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Craig A. Renner Primary Examiner Art Unit 2627

CAR